

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF :
Melchor Daumal Castellon : EXAMINER: Catherine A. Kelly
SERIAL NO: 10/533,895 : CONFIRMATION NO. 8002
FILED: May 5, 2005 : GROUP ART UNIT: 3634
FOR: ADJUSTABLE RAIL FOR POWER :
WINDOW DEVICES FOR MOTOR :
VEHICLES :
:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

MADAM:

In response to the Office action dated October 29, 2008, Applicant requests a pre-appeal brief review. A Notice of Appeal and associated fee are submitted herewith. Applicant's remarks are as follows:

SUMMARY OF THE OFFICE ACTION

Claims 1-10 remain pending with claim 1 being the sole independent claim. In the Office Action, claims 1, 2 and 5-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,425,204 to *Renner* in view of U.S. Patent No. 4,442,632 to *Greco et al.*; claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Renner* and *Greco et al.* as applied to claim 1, and further in view of U.S. Patent No. 3,844,064 to *Yamaha et al.*; claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Renner* and *Greco et al.* as applied to claim 1 and further in view of U.S. Patent No. 5,038,519 to *Huebner*; and claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Renner* and *Greco et al.* as applied to claim 9 and further in view of U.S. Patent No. 2,818,251 to *Lenz et al.*

SUMMARY OF THE INTERVIEW

Applicant wishes to thank Examiner Kelly and Examiner Mitchell for the interview granted to Applicant's representative on December 2, 2008. During the interview, withdrawal of the finality of the October 29, 2008 Office Action was discussed. Per Examiner Kelly's request, Applicant submits arguments, detailed below, regarding withdrawal of the finality of the Office Action.

WITHDRAWAL OF THE FINALITY OF THE OCTOBER 29, 2008 OFFICE ACTION

Applicant respectfully requests withdrawal of the finality of the October 29, 2009 Office Action (hereinafter "second Office Action"). Applicant submits that a new ground of rejection was presented in the second Office Action rendering the finality improper.

In the first non-final Office Action of April 30, 2008 (hereinafter "first Office Action"), independent claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Renner* in view of *Greco et al.* A § 103 rejection requires the following:

- (A) the relevant teachings of the prior art relied upon,
- (B) the differences in the claim over the applied references,
- (C) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

See MPEP § 706.02(j). With respect to the claimed limitation of "a washer having a surface complementary to the shape of said protrusion", the first Office Action failed to establish at least (C) and (D) as required. Indeed, there was no mention at all in the first Office Action of a washer with a surface that complements the protrusion shape. That is because the prior art, such as *Greco et al.*, shows only a flat washer which clearly does not complement the rounded shape of the mating part 300 of *Renner* (designated in the Office Action as the protrusion of the claimed invention).

Recognizing the deficiencies of the first Office Action, the second Office Action included an entirely new argument in the second Office Action, thereby applying the cited references in an

entirely new way. That argument included a new paragraph not found in the first Office Action regarding obviousness and the motivation of one skilled in the art, as required by (C) and (D) above, for teaching the claimed washer. More specifically, the Examiner argued the following:

While the washer shown in the '632 reference is shown flat, Examiner notes that it is mating with a flat surface, and to mate with a curved or protruding surface, such as that shown by the nut 59 in the '204 reference, would be mere design choice change in shape and thus obvious, see MPEP 2144.04 IV Section B. It would have been obvious to one of ordinary skill in the art at the time of invention as the use of washers with screws and nuts was known in the art at the time. Page 2 of the second Office Action.

None of the above language can be found in the first Office Action. In the second Office Action it is suggested that the above arguments are a clarification of the rejection in the first Office Action. However, given that these arguments address the basic requirements for a 103 rejection, that were completely missing in the first Office Action, such is not a mere clarification: it is a new ground of rejection. It is not the case that Applicant simply overlooked description in the specification or drawings that showed the claimed washer. And nothing in the second Office Action suggests the claimed washer is inherent in the references. Instead, the second Office Action provides a new argument regarding obviousness not found anywhere in the record. Thus, the Applicant had no way of understanding from the first Office Action that the Examiner believed the claimed washer is obvious as a "mere design choice." And neither cited reference individually shows the claimed washer. In such cases, it is the Examiner's burden, as outlined in MPEP 706.02(j) to establish why the claimed limitation is not obvious. That was not done in the first Office Action and Applicant should not be penalized because of that.

In view of the foregoing, Applicant requests reconsideration and withdrawal of the finality of the second Office Action.

REJECTION OF CLAIMS 1-2 AND 5-9 UNDER 35 U.S.C. § 103(a)

Claims 1, 2 and 5-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,425,204 to *Renner* in view of U.S. Patent No. 4,442,632 to *Greco et al.* Applicant submits that contrary to the suggestion in the second Office Action, one skilled in the

art would not understand changing the shape of the *Greco et al.* washer as being a mere design choice. Such a conclusion can only be based on improper hindsight of Applicant's invention.

In the second Office Action, it is suggested that it would have been a mere design choice to change the shape of the flat nut of *Greco et al.* to complement the rounded shape of the mating part 300 of *Renner*. Applicant respectfully disagrees.

No evidence is provided to support the conclusion that the claimed washer is a mere design choice. In fact the complementary surface of the washer, as recited in claim 1, is not merely a design choice because, as Applicant's disclosure states (paragraphs [0008]-[0010] and [0040]-[0042]), the complementary surface of the washer allows for easy rotation of the adjustable rail with respect to the vehicle door. The Office Action provides no evidence that such was already known in the art or obvious to one skilled in the art. Moreover, nothing in *Renner* suggests (and the Examiner has not pointed to anything in *Renner*) that the rounded shape of the mating part 300 is to allow movement in multiple directions. The only teaching of that is in Applicant's disclosure.

None of the cited prior art either individually or combined teaches a washer with a complementary surface with a protrusion. Thus, the Examiner's assertion appears to be derived from Applicant's disclosure, not from the prior art. And the Examiner has not cited any prior art that suggests a complementary washer is well known in the art.

In view of the foregoing, a *prima facie* case of obvious has not been established. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-2 and 6-9 under 35 U.S.C. § 103(a).

REJECTIONS OF CLAIMS 3 AND 4 UNDER 35 U.S.C. § 103(a)

Regarding the rejections of claims 3 and 4 under 35 U.S.C. § 103(a), Applicant submits that the rejection should be withdrawn for the same reasons discussed above with respect to claim 1.

REJECTION OF CLAIM 10 UNDER 35 U.S.C. § 103(a)

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Renner* and *Greco et al.* and further in view of *Lenz et al.* Claim 10 is also allowable for the same reasons discussed above. Moreover, it is suggested in the Office Action that *Lenz et al.* teaches a spring nut in col. 5, lines 11-13 that could be combined with the other prior art. However, nothing in *Lenz et al.*, including col. 5, lines 11-15, teaches a spring nut. Therefore, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) of claim 10.

CONCLUSION

Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (001058-00020). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicant hereby petitions under 37 C.F.R. §1.36 (a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

BLANK ROME LLP

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By: /Tara L. Marcus/
Tara L. Marcus
Reg. No. 46,510

600 New Hampshire Ave., N.W.
Washington, D.C. 20037
Telephone: (202) 772-5800
TLM/rrs